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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/050,249	03/30/1998	HARUKI OKAMURA	OKAMURA=2B	6601

1444 7590 12/14/2006

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EXAMINER	
JIANG, DONG	

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/050,249	Applicant(s) OKAMURA ET AL.	
	Examiner Dong Jiang	Art Unit 1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *93, 95 and 98-120*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See "Continuation of 7".
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

GARY B. NICKOL, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation of 5. Applicant's reply has overcome the following rejection(s): The scope of enablement rejection, and lack of written description rejection of claim 118 under 35 U.S.C. 112, first paragraph.

Continuation of 7. Claims 93, 95 and 98-120 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (Infect. Immun. 61: 64-70, 1993), for the reasons set forth in the previous Office Actions.
Applicants argument filed on 08 May 2006 has been fully considered, but is not deemed persuasive for reasons below.
Applicants argue, at pages 9-10 of the response, that the later Okamura reference does not confirm that the IGIF in the serum (by Nakamura) was proved to be the same as that found in the liver extract, as it states that the IGIF previously found in the sera was shown to contain the same molecule as was purified from the liver extract; that Nakamura did not recognize the presence of IGIF and did not succeeded in isolating IGIF; and that Okamura indicates that IGIF may exist in an oligomeric form or many be bound another molecule, thus, Nakamura's factor is not same as IGIF of Okamura. This is not persuasive because 1) Okamura also indicates the different molecular forms of IGIF, which do not make them different molecules; 2) Okamura demonstrates that the molecular mass of 75 kDa IGIF was reduced to 19 kDa (same as Nakamura's) on 0.1% SDS-PAGE in the presence of DTT, and the N-terminal amino acid sequence is the same as that of IGIF from the liver; 3) Okamura clearly concludes "thus IGIF in the serum sample was proved to be the same IGIF as that found in the liver exact" (page 3969, the second paragraph of the left column). Merely identifying that the same molecule may exist in different physical forms does not make the molecule novel.
Further, Applicants present similar arguments as previous ones, such as the differences between the prior art "factor" and the presently claimed protein in source of isolation, MW, activity when treated with SDS-PAGE, purity, specific activity after purification. These arguments have been repeatedly addressed in detail in the previous Office Actions, and they are not persuasive for the reasons of record.
Furthermore, applicants argue that by contrast, the applicants have succeeded in isolating IGIF, and obtained an isolated monoclonal antibody (as more than 10 ug of protein was needed), whereas the technique to obtain sufficient amounts of the "factor" has not been established in the Nakamura reference, and that without a sufficient amount of Nakamura's factor, a monoclonal antibody thereto would have been difficult to obtain. This is not persuasive because 1) there is no requirement that 10 ug of the purified protein is needed for generating monoclonal antibodies, for example, cells bearing the protein of the interest are routinely used as the source of antigen for generating antibodies; and 2) merely isolating a known protein to a certain degree of purity does not necessarily constitute a novel invention.